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09/847,016	05/01/2001	Diego Gastaldi	A-6396	5647

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EXAMINER

BULLOCK JR, LEWIS ALEXANDER

ART UNIT	PAPER NUMBER
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2195

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/847,016

Applicant(s)

GASTALDI, DIEGO

Examiner

Lewis A. Bullock, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-5,7,8,18-21,27,30,32 and 37-58 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,3-5,7,8,18-21,27,30,32 and 37-58 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 01 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-5, 7, 8, 18-21, 27, 30, 32 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over SETH-SMITH (U.S. Patent 4,890,319).

As to claim 1, SETH-SMITH teaches a media services client device (subscription television system), comprising: a memory (EEPROM) for storing subscriber identification information (subscriber identification number / user specific information) (col. 21, lines 2-10); and a processor (microprocessor) configured to receive the subscriber identification information (user specific information) via a graphical user interface (col. 23, line 66 – col. 24, line 27) and a media presentation (message sent with template), wherein the processor is configured to insert the subscriber identification information (user specific information) into the media presentation (message sent with template / copyright protected information) (col. 21, lines 1-10), wherein the processor is located in a media services client device (decoder), wherein the processor is configured to insert the subscriber identification information (user specific information) into the media presentation (message sent with template / copyright protected information) (col. 21, lines 1-10; col. 24, lines 62-67; col. 26, lines 12-28) wherein the subscriber identification information is invisible to a viewer of the media presentation (col. 4, lines

56-59). SETH-SMITH teaches the template/flag is stored in the vertical blanking interval of the media presentation (col. 7, lines 22-30; col. 8, lines 52-63; col. 10, lines 33-46). However, SETH-SMITH does not explicitly mention that the insertion is performed **during** the vertical blanking interval. It is obvious to one skilled in the art that since the template/flag is completed by inserting the data, that the insertion is performed during the vertical blanking interval of the presentation.

As to claim 3, SETH-SMITH teaches the processor is located in a media services client device (decoder), wherein the processor is configured to receive the media presentation from an in band pathway delivered from a media services server device (col. 21, lines 1-10; col. 24, lines 62-67; col. 26, lines 12-28).

As to claim 4, SETH-SMITH teaches the processor is located in a media services client device (decoder), wherein the processor is configured to receive the subscriber identification information (user specific information / address information / client addressed message) inputted from a remote control device (key pad / bar code reader) (col. 24, lines 15-21; col. 20, lines 37-39; col. 1, line 30 - col. 2, line 2; col. 19, lines 38-63).

As to claim 5, SETH-SMITH teaches the processor is configured to transmit a media presentation request to a media services server device (via request for program) (col. 23, line 66 – col. 24, line 27) and receive the subscriber identification information

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(user specific information / address information) (col. 21, lines 1-10; col. 24, lines 62-67; col. 26, lines 12-28). SETH-SMITH also teaches the user indicates which tiers he wished to view to the broadcaster by using a signal that is not the media presentation signal (col. 10, lines 51-55). It would be obvious that this signal is an out-of-band signal and that the subscriber identifier must be sent and used in order to identify the correct subscriber.

As to claim 7, SETH-SMITH teaches the subscriber identification information is bar-code inputted information (col. 19, lines 53-63). It is obvious to one skilled in the art that bar-code information on the bar-code chip cannot be rewritten without generating another bar-code chip and is therefore write protected. It is also obvious to one skilled in the art that since the information is guarded and used for correlation between the decoder and the secret serial number that the information is write protected.

As to claim 8, SETH-SMITH teaches the processor is further configured to demultiplex, decrypt, and decompress the subscriber identification information and the media presentation in the media services client device (col. 6, lines 52-64).

As to claim 18, SETH-SMITH teaches the processor is further configured to insert the subscriber identification information in to the media presentation to enhance tracing copying of the media presentations (col. 25, lines 3-9).

As to claim 19, SETH-SMITH teaches a method for inserting subscriber identification information into media presentations, the method comprising steps of: receiving subscriber identification information (subscriber identification number / user specific information) via a graphical user interface (col. 21, lines 2-10; col. 23, line 66 – col. 24, line 27); storing the subscriber identification information in memory (col. 21, lines 2-10); receiving a subscriber request for a media presentation (via the user indicates which tiers he wished to view to the broadcaster by using a signal that is not the media presentation signal / via the user using the keypad via the buy button) (col. 10, lines 51-55) (col. 24, lines 15-21; col. 20, lines 37-39; col. 1, line 30 - col. 2, line 2; col. 19, lines 38-63); and inserting the subscriber identification information into the media presentation requested by a subscriber, wherein the inserting of the subscriber identification information occurs at a media services client device (decoder), wherein the media services client device inserts the subscriber identification information into the media presentation (col. 21, lines 1-10; col. 24, lines 62-67; col. 26, lines 12-28) wherein the subscriber identification information is invisible to a viewer of the media presentation (col. 4, lines 56-59). SETH-SMITH teaches the template/flag is stored in the vertical blanking interval of the media presentation (col. 7, lines 22-30; col. 8, lines 52-63; col. 10, lines 33-46). However, SETH-SMITH does not explicitly mention that the insertion is performed **during** the vertical blanking interval. It is obvious to one skilled in the art that since the template/flag is completed by inserting the data that the insertion is performed during the vertical blanking interval of the presentation.

As to claim 20, SETH-SMITH teaches the receiving subscriber information occurs at a media services client device (decoder) (col. 24, lines 15-21; col. 20, lines 37-39; col. 1, line 30 - col. 2, line 2; col. 19, lines 38-63; col. 21, lines 2-10)

As to claim 21, SETH-SMITH teaches the media services client device (decoder) receives the subscriber identification information and the request for the media presentation from a remote control device (key pad / bar code reader) (col. 24, lines 15-21; col. 20, lines 37-39; col. 1, line 30 - col. 2, line 2; col. 19, lines 38-63; col. 21, lines 2-10).

As to claim 27, SETH-SMITH teaches the storing step occurs at the media services client device (decoder) (col. 21, lines 2-10).

As to claim 30, SETH-SMITH teaches the step of receiving the media presentation from the media services server device (broadcaster / transmitter) (abstract; col. 6, lines 52-64).

As to claim 32, SETH-SMITH teaches a media services server device transports the media presentation to the media services client device as a compressed and encrypted media stream (col. 6, lines 52-64).

As to claim 37, SETH-SMITH teaches the subscriber identification information is bar-code inputted information (col. 19, lines 53-63). It is obvious to one skilled in the art that bar-code information on the bar-code chip cannot be rewritten without generating another bar-code chip and is therefore write protected. It is also obvious to one skilled in the art that since the information is guarded and used for correlation between the decoder and the secret serial number that the information is write protected.

3. Claims 38-40 and 43-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over CITTA (U.S. Patent 4,554,579) in view of SETH-SMITH (U.S. Patent 4,890,319).

As to claim 38, CITTA teaches a media services server device (head end device) comprising: a processor configured to transmit subscriber identification information (subscriber address/ program authorization data) and a media presentation (program signals) via a network, wherein the processor (processor of CATV head end) is configured to insert the subscriber identification information into the media presentation (col. 8, lines 25-38; col. 3, lines 29-45; col. 2, lines 55-68). It would be obvious that since the head end device embeds and transmits the identification information to the subscriber to be rechecked by the subscriber based on its stored version of the authorization code, the head end must store the identification information also (see also col. 1, lines 35-41). However, CITTA does not explicitly teach that the subscriber identification information is invisible to a viewer during the display of the media presentation.



SETH-SMITH teaches a CATV system for sending a media presentation with embedded information wherein the subscriber identification information is invisible to a viewer during the display of the media presentation (col. 4, lines 56-59). Therefore, it would be obvious to one skilled in the art at the time of the invention to combine the teachings of CITTA with the teachings of SETH-SMITH in order to facilitate the receiving of individual text messages by individual subscribers in response to queries by the subscriber, in response to the desire of the broadcaster, or upon initiation by the decoder itself (col. 3, lines 49-53).

As to claim 39, SETH-SMITH teaches the processor is configured to receive a request for the media presentation from a media services client device (col. 3, lines 49-53).

As to claim 44, CITTA teaches the processor is configured to transmit the subscriber identification information to a media services client device (subscriber terminal) (col. 8, lines 25-38; col. 3, lines 29-45; col. 2, lines 55-68).

As to claim 45, CITTA teaches the two-way communication of packets and subscriber information between a subscriber terminal and head end device (abstract). However, none of the applied prior art references teach that the information is delivered via an out-of-band pathway. Official Notice is taken in that it is well known in the art that subscriber information is transmitted via out-of-band pathways or in-band pathways.

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Therefore, it would be obvious to one skilled in the art that the subscriber information is sent through the well-known pathways to be inserted in the media presentation as detailed CITTA in order to encode information in a media presentation to be sent to the correct decoder.

As to claim 47, SETH-SMITH teaches the processor is configured to encode, compress, and encrypt the subscriber identification information with the media presentation (col. 3, lines 54 – col. 4, line 11).

As to claim 40, 46, 48 and 49, CITTA teaches the subscriber identification information is transmitted as part of a data packet (col. 8, lines 25-38; col. 3, lines 29-45; col. 2, lines 55-68). However, none of the applied prior art references disclose that the packet is a MPEG transport stream having a program map. Official Notice is taken in that a MPEG transport stream having a program map is well-known multimedia transport stream to one of ordinary skill in the art. Therefore, it would be obvious to one skilled in the art at the time of the invention to have the packet and teachings as disclosed above be a MPEG packet in order to communicate in a MPEG format.

As to claims 50-56, refer to claims 38-40 and 44-49 for rejection.

4. Claims 41-43, 57 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over CITTA in view of SETH-SMITH as applied to claim 38 above, and further in view of BEYERS (U.S. Patent 5,724,525).

As to claims 41-43, CITTA and SETH-SMITH substantially disclose the invention above. However, CITTA and SETH-SMITH do not teach the use of a client device identifier. BEYERS teach the processor is further configured to receive a media services client device identifier (subscriber terminal capabilities) from a media services client device (via the subscriber registering with the billing computer and the information is retrieved from the billing computer or directly registering with the control computer) (col. 5, lines 16-40; col. 24, lines 50-60; col. 25, lines 15-35). Therefore, it would be obvious to one skilled in the art at the time of the invention to combine the teachings of CITTA with the teachings of SETH-SMITH and BEYERS in order to allow various data to be easily correlate with a system control computer database such that specific subscribers may be selected for messages to be sent based on all criteria (col. 2, lines 56-64).

As to claims 57 and 58, refer to claims 41-43 for rejection.

***References Cited, but not Relied Upon***

U.S. Patents 5,818,438, 5,497,187 or 5,257,396, all cited in the Notice of References Cited filed 2/10/05 disclose that sending of subscriber identification

information via an in-band, out-band, or any other transmission stream to be included in the media presentation.

### ***Response to Arguments***

5. Applicant's arguments filed 5/13/05 have been fully considered but they are not persuasive. Applicant argued that Seth-Smith does not teach the subscriber identification information is received via a graphical user interface. The examiner disagrees. At column 23, line 66 – column 24, line 27, Seth-Smith teaches that when a user wishes to have a babysitter watch his children, in order for a specific program to be displayed a specific user identification number must be entered before it will accept input from a BUY button through a menu driven user interface. Therefore, the user identification code is received via a graphical user interface as detailed in the claims. In regards to the finding of inherency, it is the examiners position that the sending of identification information via the in-band or out-of-band signal is well known in the art. The examiner has cited numerous references that teach this well-known feature.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis A. Bullock, Jr. whose telephone number is (571) 272-3759. The examiner can normally be reached on Monday-Friday, 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 1, 2005

  
LEWIS A. BULLOCK, JR.  
PRIMARY EXAMINER